

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: A. Wade Cohn, *et al.*

Serial No.: 10/734,911

Filed: December 12, 2003

Title: CROSS-CHANNEL COMMUNICATION OF DATA COLLECTED BY
CHANNEL-SPECIFIC USER INTERFACES

Grp./A.U.: 2614

Examiner: Rasha S. Al Aubaidi

Confirmation No.: 2291

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

I hereby certify that this correspondence is being electronically filed
with United States Patent and trademark Office on:
May 24, 2010 (Date)

Elizabeth Schumacher

(Printed or typed name of person signing the certificate)

/Elizabeth Schumacher/

(Signature of the person signing the certificate)

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Applicants have carefully considered this application in connection with the Final Rejection asserted in an Office Action delivered February 23, 2010 and respectfully request a pre-appeal brief review of this application in view of the following remarks.

REMARKS/ARGUMENTS

The Office has rejected Claims 1-8, 11-14, 18-23, 25-28, 31-34, 37-40 and 43-52 under 35 U.S.C. § 103(a). Independent Claims 1, 19, 25, 31 and 37 are rejected over U.S. Patent No. 5,884,032 to Bateman, *et al.* ("Bateman") in view of U.S. Patent No. 6,456,699 to Burg, *et al.* ("Burg"), further in view of U.S. Patent No. 5,148,469 to Price ("Price") and further in view of U.S. Patent No. 4,390,953 to Johnstone ("Johnstone"). The Applicants bring this Appeal on the grounds that for at least the reasons described below, the asserted combination fails to support a *prima facie* case of obviousness of independent Claims 1, 19, 25, 31 and 37, and that the rejection of the dependent claims fails to cure the deficiency of the rejection of the independent claims. Claim 1 is treated below, with the analysis being applicable to each of Claims 19, 25, 31 and 37, *mutatis mutandis*.

THE ASSERTED COMBINATION FAILS TO TEACH EACH AND EVERY FEATURE OF THE CLAIMS

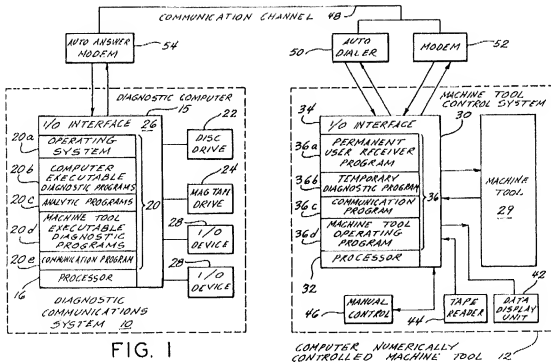
It is axiomatic that all elements of the claims must be found in the cited combination of references to find the claims obvious under § 103. (*See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).) In the February 23 Action, the Office concedes that the combination of Bateman, Burg, and/or Price fails to specifically teach the feature of Claim 1,

coordinating the first communication channel with the second communication channel

(*See* page 5). The Office Action introduces Johnstone to cure the deficiency of the combination of Bateman, Burg, and/or Price. The Office Action cites Johnstone as teaching "automatically initiate a communications link across a communication channel such as a telephone line", and associates this teaching with "the first communications channel" of the above-recited portion of Claim 1. (*See* page 5.) The Feb. 23 Action further cites Johnstone as teaching "the diagnostic computer transmits control instructions to the computer controlled machine tool." (*See id.*, pp. 5-6.) The Office then makes the unjustifiable conclusion that the Claim 1 is obvious because this teaching "can read on the second communication channel that is coordinated with the first communication channel." (*See id.*)

Johnstone teaches a communications system, with illustrative Fig. 1 reproduced below. A diagnostic communications system 10 communicates with a computer numerically controlled machine tool 12. The system 10 is linked to the machine tool 12 by a communication channel 48. Johnstone describes the communications channel 48 as being "a long distance telephone link or a microwave channel connected at each end to a local telephone link" (Column 4, lines 26-28.)

Thus, the Applicants only find a teaching in Johnstone of a single communications channel. The claim feature at issue includes coordination of a first and a second communication channel. But because Johnstone has only one communications channel, the combination as applied does not teach this feature of Claim 1. Furthermore, the Office fails to cite any suggestion that Johnstone includes communication on anything other than the communications channel 48. Moreover, the Office Action includes no reasoned analysis that supports interpreting the communication channel 48 as including more than one communication channel, or that supports interpreting the control instructions as a second communication channel. Accordingly, Johnstone as applied does not teach or suggest the above-recite feature of Claim 1, and the asserted combination fails to support a *prima facie* case of obviousness.



THE ASSERTED COMBINATION RENDERS BATEMAN UNSUITABLE FOR ITS INTENDED PURPOSE

Furthermore, the Applicants note that a *prima facie* case for obviousness involves modification of the primary reference. Implied by the asserted combination is the modification of Bateman to include only the single communication channel.

A proposed combination that would render a prior art invention unsuitable for its intended purpose is improper. (See MPEP § 2143.01(V), citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).)

The asserted modification of Bateman to include only a single communications channel would eliminate either, e.g. Bateman's telephone line 10 or internet access line 47. The Office Action does not include any reasoned analysis that such a modification would not make Bateman unable to provide the various help transactions described therein.

Therefore, the combination as asserted renders Bateman unsuitable for its intended purpose and the *prima facie* case of obviousness fails.

THE OFFICE APPLIES AN ERRONEOUSLY BROAD READING OF THE SCOPE OF THE CLAIMS

The Office is permitted to give claims their broadest reasonable construction consistent with the specification. (See, e.g., MPEP § 2111, citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005).) However, the Federal Circuit recently recognized limits on claim interpretation by the Office, stating:

The broadest-construction rubric coupled with the term "comprising" does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent.

(*In re Suitco*, No. 2009-1418, 2010 WL 1462294, at *4 (Fed. Cir. Apr. 14, 2010)).

The Office Action reads impermissible breadth into Claim 1 by reading the claim as including the single communications channel of Johnstone. Thus, Johnstone is a nonapplicable reference, and the asserted combination fails to withstand scrutiny under the standard established in *Suitco*. Accordingly, the *prima facie* case of obviousness fails.

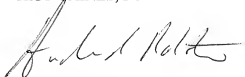
Conclusion

In view of the foregoing remarks, the Applicants respectfully request that the Office withdraw the rejection of Claims 1-8, 11-14, 18-23, 25-28, 31-34, 37-40 and 43-52 and issue a Notice of Allowance therefore.

The Applicant requests the Reviewers to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, PC

A handwritten signature in black ink, appearing to read "Andrew R. Ralston", is written over a horizontal line.

Andrew R. Ralston
Registration No. 55,560

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P.O. Box 832570
Richardson, Texas 75083
(972) 480-8800